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REMARKS

The Decision on Appeal dated March 21, 2007 has been received and its contents carefully noted. In view thereof, as well as the Official Action dated, April 1, 2005, this preliminary amendment to accompany Applicant's filing of a Request for Continued Examination, claims 1-26 have been cancelled and new claims 27-52 have been added in order to more clearly define that which Applicant regards as the invention. Accordingly, claims 27-52 are presently pending in the instant application.

In the April 1, 2005 Office Action, claims 1-19 and 23-26 were rejected under 35 U.S.C. §103(a) as being unpatentable over WO 96/24213 A1 of Goldschmitt (hereinafter "Goldschmitt"), in view of U.S. Patent No. 6,029,141 to Bezos et al. (hereinafter "Bezos"). In light of the amendment above and for the reasons discussed below, Applicant respectfully submits that the disclosures of these references do not present a *prima facie* case of obviousness.

Initially, it is to be noted that the present application was filed on March 16, 1999 and thus, the Examiner, when presenting his *prima facie* case of obviousness must consider the state of the art at that time and place himself in the shoes of one of ordinary skill in the art as it was prior to March 16, 1999 and not as it is today.

We would like to emphasize and to the greatest extent possible, clarify that the Glaser teachings seek to protect the idea that a user on a network seeking only to communicate to another user, will find advertisements automatically embedded into the communications, according to pre set preferences. On top of this teaching, that the use of or purchase of hardware or software can leverage this preexisting concept (assuming the user has invoked and enabled the invention) to the extent that the user, by merely acquiring said hardware or software and using it, automatically causes advertisements to embed in any subsequent communications, limited only according to preferences. As this relates to the claimed invention and the prior art we have collectively examined, we know of no system or solution to accomplish what the present invention accomplishes, from the sender to the receiver. Applicant does not

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discredit or ignore the teachings of the prior art, but does feel, very strongly, each invention stands alone and the individual art cited or the combination of Goldschmidt, Bezos and Uomini absolutely do not teach Applicant's claimed invention. Or in lay terms, each of Goldschmidt, Bezos and Uomini had specific inventions, goals, claims and intent, well expressed in the four corners of their respective disclosure and patent grant(s). The differences in the present invention as compared to the prior art, as stated above, center on the intent to automate the advertising process within the sender's data processing system, into potentially all subsequent communications leaving a senders data processing system and further, to automate the addition of new advertisements associated with the purchase of new hardware or software thereafter, so the user need not remember or do anything except buy and use their choice hardware or software, to automatically advertise for these items thereafter. It is respectfully submitted, that the present invention has been set forth in such a manner as to overcome previous objections and rejections of record and place the present application in proper condition for allowance.

If raised as questions, where do each or Goldschmidt, Bezos or Uomini automate the advertising process such that advertisements will be automatically embedded in a sender's subsequent communications? How can Goldschmidt, Bezos or Uomini cause a sender's newly purchased hardware or software to automatically advertise itself just through the act of purchase and use alone?

With respect to the teachings of Goldschmidt, the Goldschmidt teachings center on the network server and cause the network server to append advertisements to emails sent by a user on the network. In contrast, in accordance with the claimed invention the advertisement is embedded into the communication automatically, in the sender's data processing system, which is not taught in the four corners of Goldschmidt, or even intimated in the figures or drawings of Goldschmidt. If by chance, the Examiner disagrees, we would further contend that the concept of communications from the sender's data processing system embedding advertisements

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automatically into the sender's communications, not just emails but all communications, is also absolutely not taught by Goldschmidt. Having established this unique set of functions and the automatic nature of them, Goldschmidt certainly does not contemplate an automated system for the sender and within the sender's data processing system, whereby the sender's future acquisition and use of hardware or software, automatically causes advertisements to be embedded in either their emails or all their communications. As to Goldschmidt's specificity, in the Goldschmidt document, Page 3, at 25, Goldschmidt specifically recites where the email presides, that when an already sent email presiding in a network server is selected only then is an advertisement *appended (emphasis added.)* In this regard, it is noted that the Goldschmidt solution will have an inherent inability to reach out and change the advertisements. In Goldschmidt, all advertisements, their embedding or appending and the recipient's status are all lost to the sender in the Goldschmidt teachings. On Page 13, at 10 and 15, Goldschmidt repeatedly references the place where the emails preside before advertisements are added. It is abundantly clear in these paragraphs and elsewhere in Goldschmidt, that Goldschmidt was not contemplating that the sender's data processing unit perform the task of selecting and appending advertisements and certainly does not suggest embedding the advertisements, only, appending after a delimiter and then, only in a server on the network.

With respect to Bezos, the Examiner states that "Bezos discloses embedding an advertisement within communication and associating within the user-managed data processing system (i.e. can disseminate catalogs. . .e-mail newsletters. . .that include the associate's reviews and/or recommendations on specific products sold by the merchant). However, in so far as this rejection applies to new claim 27, this claim is directed to a method of automatically transmitting an advertisement from a sending party to a receiving party comprising the steps of (1) initiating a communication from a data processing system of a sending party; (2) associating at least one pre-selected advertisement with said communication within the data processing system of the

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sending party; and (3) transmitting said communication with said at least one advertisement automatically embedded therein to the recipient. Clearly, the teachings of Bezos when combined with that of Goldschmidt fails to achieve such a method.

The Examiner cited Col. 1, lines 50-61 of Bezos as disclosing embedding advertisement within a communication. However, the cited text in Bezos discloses a software system and method for enabling an Internet sales merchant, to market and sell goods in cooperation with Web sites or other networks sites of respective business partners, referred to as "associates." The merchant can enroll as an associate, and can disseminate catalogs (web documents, PUSH documents, e-mail newsletters, etc.) that include the associate's reviews and/or recommendations on specific products sold by the merchant. The associate catalog documents include product-specific hyperlinks (i.e., referral links), defined as a navigational link from one document to another, or from one portion of a document to another. Unlike the present invention of claim 27, however, the disseminated catalogs do not have advertisements automatically embedded therein. Little if anything set forth in Bezos is carried out automatically. Consequently, it is respectfully submitted that the teachings of Bezos even if combined with that of Goldschmidt fails to render the claimed invention obvious.

In other words, contrary to the Examiner's understanding, Bezos does not teach the association of advertisements in a communication and transmitting the communicating with the advertisement automatically embedded therein to a recipient. Instead, as disclosed by Bezos, an "associate" web site provides a hypertextual "referral link" that allows a customer visiting the associate's web site to link to the merchant's web site by clicking on a "referral link" to initiate purchases of products from the merchant, which subsequently allows the merchant to identify the product and its referring associate.

Further, as summarized and acknowledged by the Examiner in the Interview Summary dated March 30, 2004, the advertisement in Bezos is under control of a third party and not under the local control of the sending party. That is, a user or customer

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has no control of the display or promotion of the products offered by the merchant or its associates. As set forth above, Bezos' internet-based customer referral system is clearly different from the method of transmitting a communication including an automatically embedded advertisement of the presently claimed invention.

As to the teachings of Uomini, this reference does not teach anything of relevance to the present invention, because the claimed invention does not send emails with signature files, rather, the claimed invention sends communications with the advertisement automatically embedded therein. Where the present invention sends an email, the email already has the advertisements automatically embedded in, prior to transmission from the sender's data processing unit. In fact, Uomini was invented for those communications that leave the sender with only a signature file so the recipient can potentially get more information about the signature file and the email. Uomini specifically teaches a method through which upon receipt of an email, a user (receiver) can query embedded signature files to get more information from various servers on the internet. Uomini applied to the combination of Goldschmidt and Bezos, does not overcome the aforementioned shortcomings associated with such combination. Specifically, none of the prior art references teach or even remotely suggest automatically embedding advertisements in the sender's data processing system as is the case with Applicant's claimed invention. Only Applicant teaches and claims method of communicating and transmitting the communication with the advertisement automatically embedded therein to a recipient. Moreover, the prior art references clearly fail to disclose or suggest to automate the addition of new advertisements associated with the purchase of new hardware or software thereafter, so the user need not remember or do anything except buy and use their choice hardware or software, to automatically advertise for these items thereafter.

Therefore, in view of the foregoing arguments and amendments, it is respectfully requested that the rejections of record be reconsidered and withdrawn by the Examiner, that claims 27-52 be allowed and that the application be passed to issue.

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While the present application is now believed to be in condition for allowance, should the Examiner find some issue to remain unresolved, or should any new issues arise, which could be eliminated through discussions with Applicant's representative, then the Examiner is invited to contact the undersigned by telephone in order that the further prosecution of this application can thereby be expedited.

Respectfully submitted,



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